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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,715	12/30/2003	Thomas Odorzynski	19197 (27839-2575)	2119
45736 7590 12/09/2008 Christopher M. Goff (27839) ARMSTRONG TEASDALE LLP ONE METROPOLITAN SQUARE SUITE 2600 ST. LOUIS, MO 63102				
EXAMINER				
DAGNEW, SABA				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
12/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatents@armstrongteasdale.com

Office Action Summary**Application No.**

10/748,715

Applicant(s)

ODORZYNSKI, THOMAS

Examiner

SABA DAGNEW

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8, 10-18, 20, 22, 24-29 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10-18, 20, 22, 24-29, and 31-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Final Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 24, 2008 has been entered.

Claim Objections

In the March 10, 2008 response, the Applicant indicated that the duplicate claim rejections in paragraph 2 of the December 26, 2007 Office Action would be addressed at a later time if the first set of claims are found to be allowable. Thus, the Examiner maintains the objection, which has been repeated below for the Applicant's convenience.

Applicant is advised that should claims 3, 8, and 10-13 be found allowable, claims 20, 22, 24, and 27-29 will be objected to under 37 CFR 1.75 as being substantial duplicates thereof, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 3 depends from Claim 1 and thus includes three limitations: selling space on disposable diapers to a sponsor; placing an ad onto the disposable diapers; and

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selling the disposable diapers to customers. Claim 20 depends from Claim 14 and thus contains three limitations: placing a promotion onto disposable diapers; selling the disposable diapers to customers; and selling space on the disposable diapers to sponsors. Thus, Claim 3 and Claim 20 are claiming the same three limitations (the Examiner considers an ad and a promotion to be equivalent). The other claims above are dependent claims which each recite the same limitations of their corresponding claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "The diaper comprising an absorbent pad, a bodyside liner, and liquid impermeable backsheet" (in lines 3-4 is a new matter)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6, 8, 12, 14-17, 20, 22, 25, 26, 28, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Gabler (US pat. 5,481,758).

Claims 1, 3, 8, 14, 20, and 22: Gabler discloses a system and method for advertising, comprising:

- a. selling space on underwear, which reads on a disposable diaper, to a sponsor (column 2, lines 25-29 and col. 2 lines 57-60);
- b. placing an ad a product other than disposable diapers onto the disposable diaper (Fig. 3 and column 5, lines 39-57 teaches placing ad and column 2, lines 55-60); and
- c. selling the disposable diapers to customers (column 1, lines 30-35).

The Examiner notes that little, if any, patentable weight is given to the type of clothing onto which the advertisements are applied. The disclosure in Gabler that the advertisements could be applied to children's clothing seen only in private, such as sleep wear, novelty underwear, etc. would also inherently encompass disposable diapers and disposable diapers along with all other forms of underwear.

Claims 6, 12, and 28: Gabler discloses a system and method as in Claims 1, 8, and 22 above, and further discloses printing the ad onto the disposable diaper (column 4, lines 65-67).

Claim 15: Gabler discloses a method as in Claim 14 above, and further discloses manufacturing the disposable diapers (by citing that the advertisers pay manufacturers of articles of clothing) (column 1, lines 25-29). (Also, inherent, since

there must be a manufactured the disposable diaper before the advertisement can be placed thereon.)

Claims 16, 17, 25 and 26: Gabler discloses a system and method as in Claims 14 and 22 above, and further discloses that the ad may pertain to the article of clothing (disposable diaper) (by placing an advertisement for jeans on a pair of jeans) or not. Gabler discloses that "the content of the messages which is applied is limited only the imagination of persons making the message garment" (column 3, line 2-9). The Examiner also notes that little, if any, patentable weight is given to the product or type of product being advertised by the ad. It is inherent, as disclosed by Gabler that any message may be placed on the article of clothing (disposable diaper).

Claims 31 and 32: Gabler teaches the further limitation that the promotion is in the form of a "code" as noted for claims 14 and 22, because the broadest reasonable interpretation of "code" is any writing. (Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). The specification gives no explanation for "code".)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 7, 10, 11, 13, 18, 24, 27, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabler (5,481,758) in view of Iwamoto (WO 03/023496).

Claims 4, 5, 10, 11, 24, and 27: Gabler discloses a system and method as in Claims 1, 8, and 22 above, but does not explicitly disclose placing a plurality of ads on the disposable diaper. However, Iwamoto discloses a similar system and method for advertising on clothing that places a plurality of advertisements on the front, back, sides, etc. of the clothing (Abstract and Figures 1 and 17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gabler to place one or more additional advertisements on the front, back, sides, or other desired place on the disposable diaper. One would have been motivated to place more than one ad on the disposable diaper in order to increase revenue for the manufacturer since each advertiser would be paying for the ad placement.

Claims 7, 13, and 29: Gabler discloses a system and method as in Claims 1, 8, and 22 above, but does not explicitly disclose attaching a detachable ad to the disposable diapers. However, Iwamoto discloses a similar system and method for advertising that discloses the ad may be printed onto the clothing or attached in a plurality of detachable manners (Abstract and Figures 2-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Gabler to detachably attach the ad to the disposable diaper. One would have been

motivated to use a detachable ad in order to allow the user to retain the ad after the disposable diapers were used.

Claim 18: Gabler discloses a method as in Claim 14 above, but does not explicitly disclose that the commercial advertisement on the disposable diaper is a coupon. However, a coupon is one well known type of commercial advertisement that has been detachably attached to products for many years. Thus, taken with the disclosure in Iwamoto of using detachable advertisements as discussed above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a coupon as the advertisement or as part of the advertisement. One would have been motivated to include a (detachable) coupon in order to entice the customer to purchase the advertised product (whether it was for more disposable diapers or some other product).

With respect to claim 33, Gabler in view of Iwamoto addressed by the rejection as cited above.

Response to Arguments

Applicant's arguments filed 24 October 2008 have been fully considered but they are not persuasive.

a. The Applicant argues in reference to 1, 8, 14, and 22 that Gabler does not disclose that the piece of clothing to which the advertisement is attached is a disposable diaper (pages 8-11). This has been addressed in the rejection above. Little, if any, patentable weight is given to the type of clothing. Furthermore, Gabler does explicitly disclose that the clothing can be children's underwear (among other types of children's

clothing). Disposable diapers are children underwear. Thus, one having ordinary skill in the art at the time the invention was made would have known to include disposable diapers and disposable diapers within the scope of clothing types onto which Gabler can attach the advertisement.

b. As per the Applicant's argument that a disposable diaper is different because it includes such features as absorbent pads, bodyside liner, liquid previous topsheet, liquid impervious backsheet, etc. (pages 10-11), it is noted that the Applicant is arguing limitations not presently in the claims. Furthermore, how the article of clothing is made or what types of material it is composed of does not affect the steps of attaching one or more advertisements to the article of clothing. Many other articles of clothing also include one or more of these features, such as rainwear which includes liquid pervious and impervious layers to prevent the wearer from getting wet. Thus, even if the claims were amended to include these limitations, the attachment of the advertisement would need to be somehow tied to the specific components (layers) of the disposable diaper and shown to be inoperable with other types of clothing (such as the above rainwear) to render it non-obvious to one having ordinary skill in the art.

Additionally, Applicant in page 10 cited four patent which shows disposable diaper includes absorbent pad, a bodyside liner, and a liquid impermeable backsheet (for example, see Tanner et al. 6, 162, 961, December 19, 2000, Fig. 8, and Col. 8, lines 40-66), one of the four patent cited by the applicant. Furthermore, "diaper comprising: an absorbents pad, a bodyside liner, and a liquid impermeable backsheet" in lines 2-4 off claim 33, is nonfunctional descriptive material because it is a description

of diaper not the step of placing advertisement. Therefore, no patentable weight is give for this limitation (MPEP § 2106.01).

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D./
Examiner, Art Unit 3688

/Raquel Alvarez/
Primary Examiner, Art Unit 3688